

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

In Re Application of:

Confirmation Number: 1974

Moore, Mark Justin

Group Art Unit: 2194

Serial No.: 10/642,309

Examiner: Wu, Qing Yuan

Filed: August 18, 2003

Docket No.: 060707-1330

For: **Operating System for Executing Computer Software Applications**

SECOND RENEWED PETITION UNDER 37 C.F.R. § 1.47(b);

**IN THE ALTERNATIVE, PETITION UNDER 37 C.F.R. §1.183 FOR SUSPENSION OF
RULES**

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In order to preserve proprietary interest in the above listed application, Petitioner hereby petitions to accept the filing of U.S. utility application, having serial no. 10/642,309, filed on August 18, 2003, said filing made on behalf of the sole inventor, Mark Justin Moore. At the time of filing, Mr. Moore executed a declaration, which was found to be defective by the U.S. Patent and Trademark Office (USPTO). This is a second renewed petition under 37 C.F.R. §1.47 to the USPTO to accept the filing of the above-referenced application on behalf of an inventor who cannot be found or reached after diligent effort. In the alternative, due to the extraordinary situation involving this application, Petitioner submits this petition under 37 C.F.R. §1.183 respectfully requesting that the Director allow the assignee to make application for patent on behalf of the sole inventor, Mr. Moore. Despite great efforts to obtain a signed declaration from Mr. Moore, Assignee's petition submitted November 23, 2009 and renewed petition

submitted April 29, 2010 have been denied. Assignee believe that given the present extraordinary circumstances, the requirement of due diligence under 37 C.F.R. §1.47(b) should be suspended or waived by the Director.

STATEMENT OF FACTS

1. On August 18, 2004, a Declaration signed by the sole inventor, Mr. Moore, was submitted to the USPTO in response to a Notice to File Missing Parts.
2. In the first non-final Office Action dated July 2, 2007, the Declaration was rejected for being defective. Specifically, the declaration stated that the inventor believed that he was the original and sole inventor and did not include the term "first."
3. Despite Applicant's arguments regarding the sufficiency of the executed Declaration, the USPTO was unwilling to accept the Declaration. Since filing of the Declaration, Mr. Moore ceased his employment with the assignee of the present application and has been unreachable, as indicated in the previously-submitted petitions.
4. On November 23, 2009, a Petition under 37 C.F.R. §1.47 To Accept Filing of Application Made on Behalf of an Inventor Who Cannot be Found or Reach After Diligent Effort was submitted. As set forth in that petition, the present application was filed with a Declaration on August 18, 2003. At that time, the sole inventor Mr. Moore was employed by Globespan Virata and the present application was assigned accordingly. Mr. Moore was employed by Globespan Virata until December 10, 2002. Two years later, Conexant Systems, Inc. and Globespan Virata merged and the present application was assigned to Brooktree Broadband Holding, Inc., which is a wholly owned subsidiary of Conexant Systems, Inc. The Assignee's records show a last known address for Mr. Moore as 7 George Street, Cambridge, CB 4 1AL, UK.

Petitioner had attempted to locate Mr. Moore to execute a new declaration. More specifically, Patricia Dailey (Conexant employee at the time of filing) sent an e-mail to Mr. Moore on October 30, 2008 requesting his signature on the new Declaration. When Ms. Dailey did not receive a response she sent an e-mail on February 10, 2009 to the general mail box for the company Mr. Moore was believed to be employed by. After still not receiving a response to this e-mail, an e-mail was sent to Mr. Moore on October 23, 2009 requesting his signature. An e-mail was sent to Brian Knight and Martin Jackson (Mr. Moore's co-workers while Mr. Moore worked at the Assignee) on October 23, 2009 requesting Mr. Moore's current contact information. On October 26, 2009 Brian Knight replied via e-mail with the same contact information previously used to trying to locate Mr. Moore. At this time, multiple Internet searches were conducted to try and locate Mr. Moore with three telephone numbers being found. On three separate occasions, attempts were made to contact Mr. Moore at each of the numbers provided by the search with no success.

5. On January 29, 2010, a Decision on Petition was issued whereby the Petition was dismissed as the Petitioner's activities did not constitute diligent effort in trying to locate Mr. Moore.
6. On April 29, 2010, a Renewed Petition under 37 C.F.R. §1.47 was filed by Petitioner. Further efforts had been made to locate and contact Mr. Moore. As set forth in the Petition, on at least four separate occasions, attempts were made to contact Mr. Moore at certain telephone numbers with no success. Additionally, on multiple occasions, attempts were made to contact the company (Alquanto) at which Mr.

Moore was believed to be employed with the assistance of a Spanish law firm. Again, these efforts were unsuccessful.

7. On July 20, 2010, a Decision on Petition was issued whereby the Petition was again dismissed. The Decision maintained that the Petitioner's efforts did not constitute diligent effort in trying to locate Mr. Moore. Specifically, the Decision indicated that the additional step of mailing a letter to the non-signing inventor on February 12, 2010, coupled with the prior efforts, still did not constitute diligent effort in locating Mr. Moore.
8. On July 20, 2010, an Ex Parte Quayle Action was issued by the USPTO indicating that claims 1-4, 7-21, and 24-34 are allowed. The Office Action further indicated that the application is in condition for allowance except for the defective declaration. (Ex Parte Quayle Action, page 4).
9. Prior to the submission of the Renewed Petition submitted on April 29, 2010 and subsequent to the Decision on Petition mailed July 20, 2010, a number of discussions have been conducted with the assigned petitions attorney, Mr. Paul Shanoski. While Petitioner greatly appreciates the time spent by Mr. Shanoski in discussing this matter, Mr. Shanoski has not been able to provide Petitioner with specific guidance on what activities would rise to the level of diligent effort. While Petitioner appreciates that each case is fact-specific and is considered on a case-by-case basis, Petitioner has been put in a difficult position of not knowing what efforts Mr. Shanoski would find acceptable. During various telephone discussions with Mr. Shanoski, Mr. Shanoski has indicated that the additional activities described by Petitioner are insufficient. Yet, Mr. Shanoski has not been able to provide Petitioner

with guidance on what actions to take other than the suggestion to engage a private investigator. Upon further discussions with Mr. Shanoski, Petitioner agreed to invest more time and money into hiring a private investigator to help locate Mr. Moore. To date, numerous hours and resources have been spent trying to contact Mr. Moore.

10. On August 18, 2010, the firm Amsel & Company ("Amsel & Co.") was hired by Petitioner to locate Mr. Moore. Amsel & Co. provides investigative services and focuses on the area of intellectual property. An interim report was sent by Amsel & Co. on September 2, 2010. Based on Mr. Moore's listed citizenship (UK) and address provided on the originally submitted declaration, the firm was able to identify a property address on George Street, Cambridge CB4 1AL in the United Kingdom for Mr. Moore. This search result was based in part on a search of the National Voters Roll database and other databases. Initial attempts to contact Mr. Moore at that address were unsuccessful. A recommendation was made by Amsel & Co. to conduct an in-person visit to the address. This, however, would require additional cost on the part of the Petitioner. Petitioner authorized the additional expense, and an agent of Amsel & Co. was then sent to try and make contact with Mr. Moore in person.

11. Multiple visits were made to the property with no success. Finally, On September 14, 2010, an individual who was renting the property from Mr. Moore answered the door. Upon further discussion, the agent was informed that Mr. Moore had been out of the country but had just arrived back in the country. Later that evening, contact was made with Mr. Moore over the telephone by an agent of Amsel & Co. The

following is a summary of the telephone discussion between Mr. Moore and an agent of Amsel & Co. on September 14, 2010:

- a. Mr. Moore first indicated that he had just flown in from Kyoto, Japan and would be flying back out of the country to Spain on September 15, 2010.
- b. Mr. Moore would then be in Spain for only a week. After that, he would be traveling to Italy, where he would be for 2 weeks.
- c. After that, Mr. Moore indicated that he would continue his work travels and would not return to the United Kingdom until sometime next year.
- d. When asked, Mr. Moore indicated that he could not be reached via a mobile telephone and that the only way to reach him would be by an e-mail address, which he provided.
- e. Mr. Moore's final remark during the telephone conversation was that "*I will only be stable communication wise next week with regard to e-mails so this will be a good time for them to send me a communication.*"

12. Petitioners note that the e-mail address provided by Mr. Moore during the telephone call on September 14, 2010 was the same address Petitioner had utilized during earlier search efforts to no success.

13. On September 15, 2010, Amsel & Co. communicated the details of the telephone call, as set forth above. Since September 14, 2010, Petitioner has tried to contact Mr. Moore on three occasions using the e-mail address provided by Mr. Moore: September 16, 2010; September 22, 2010; and on October 8, 2010. Petitioner has not received a response from Mr. Moore. Among other documents, a declaration has been sent to the e-mail address.

14. In view of the new efforts by Petitioner since the last petition, coupled with prior efforts, Petitioner hereby renews the petition previously made to file the application on behalf of Mr. Moore, who is the sole inventor of the application. From the facts, as they now exist, Petitioner respectfully submits that this petition may be treated as either (1) a petition to file on behalf of an inventor who refuses to sign, or (2) a petition to file on behalf of an inventor who cannot be found. With regard to the first type, Petitioner respectfully submits that the actions (*i.e.*, the lack of response within the narrow window of availability provided) on the part of Mr. Moore since the telephone call on September 14, 2010 constitutes a constructive refusal to sign. Mr. Moore clearly indicated that he would “. . . *only be stable communication wise next week with regard to e-mails so this will be a good time for them to send me a communication.*” This corresponds to approximately the dates spanning September 15, 2010 to September 22, 2010. Mr. Moore indicated that this would be the best time to reach him. E-mails sent within (and beyond) this window of availability have not been responded to. Mr. Moore also indicated that he would not be reachable via mobile communications or other forms of communication. Given the transient nature of Mr. Moore’s travel status and the limited channel of communication, Petitioner submits that these actions constitute a refusal to sign.

In the alternative, Mr. Moore can no longer be found. Mr. Moore did not leave any other way to reach him other than via e-mail. Furthermore, he indicated that he would be traveling to various countries, making it difficult for Petitioner to locate Mr. Moore. Therefore, under these circumstances, reasonable efforts have been made to locate Mr. Moore, but at this time, he cannot be effectively located so as to be

presented with the declaration. Therefore, Petitioner submits that diligent (albeit unsuccessful) effort has been made to locate Mr. Moore. Mr. Moore has been presented with the declaration but constructively refused to sign it by failing to respond within the very narrow window of time in which he indicated that he would be available.

15. Accordingly, Petitioner hereby petitions the USPTO, pursuant to 37 C.F.R. §1.47, to allow the assignee, by operation of law, to file this application on Mr. Moore's behalf. Petitioner has clearly illustrated a diligent attempt to locate the sole inventor, Mr. Moore. Additionally, to preserve the rights of the assignee (Conexant Systems, Inc.) and to prevent irreparable damage to the assignee, Petitioner respectfully requests a grant of this petition.

16. In the alternative, Petitioner hereby petitions the USPTO, pursuant to 37 C.F.R. §1.183 for waiver of the due diligence requirement under 37 C.F.R. §1.47(b), assuming that the additional efforts exercised by Petitioner since the last Renewed Petition filed April 29, 2010 coupled with prior efforts are not sufficient to constitute due diligence. As noted above, an Ex Parte Quayle Action was issued on July 20, 2010 indicating that all pending claims are allowed. Here, Petitioner believes that at the time Mr. Moore signed the original declaration on May 25, 2004 (the declaration was later submitted to the USPTO on August 18, 2004), Mr. Moore understood and believed that he was the original, sole, and first inventor of the subject matter claimed. Petitioner stands to lose patent rights due to the omission of the word "first" on the declaration. Given the efforts by the Petitioner, which include many hours spent by various individuals to locate Mr. Moore (including those spent by an

investigative firm), an extraordinary situation exists given the highly transient nature of Mr. Moore's travel status and given the very limited means of communication with Mr. Moore. In view of this, Petitioner respectfully petitions that the statutes governing the requirement of diligent effort be shown on the part of the Petitioner be suspended or waived by the Director.

17. No additional fee is deemed to be payable in connection with this Petition other than those fees included with this Petition. Should any additional fee be required, you are hereby authorized to charge any such additional fee to Deposit Account No. 50-0835.

Respectfully submitted,

/ Jeffrey Hsu /

Jeffrey Hsu
Reg. No. 63,063

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